

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

STL03350.1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on Filed Electronically on August 31, 2010

Signature /Mitchell K. McCarthy/

Typed or printed name Mitchell K. McCarthy

Application Number

10/815,130

Filed

3/31/2004

First Named Inventor

Norbert Steven Parsoneault

Art Unit

3656

Examiner

Justin Krause

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Mitchell K. McCarthy/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Mitchell K. McCarthy

Typed or printed name

☒ attorney or agent of record.
Registration number 38,794

405-639-3086

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

August 31, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Norbert Steven Parsoneault**

Assignee: **SEAGATE TECHNOLOGY LLC**

Application No.: **10/815,130**

Filed: **March 31, 2004**

For: **FLUID DYNAMIC BEARING SPINDLE MOTOR**

Group Art Unit: **3656**

Examiner: **Justin Krause**

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

COMMENTS IN SUPPORT OF PRE-BRIEF REQUEST

1. The Office's rationale for the suggested combination to add Moritan's groove 23b to Tanaka is based on a mischaracterization of what Tanaka actually discloses, leaving an unresolved factual issue that must be addressed before this case is in condition for appeal.

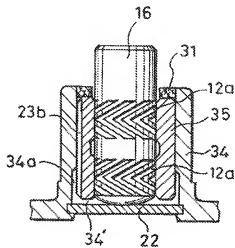
Applicant agrees with the Office to the extent of its admission that Tanaka does not teach or suggest at least the *capillary seal*, the *channel*, or the structural interconnecting features such as *fluidly communicates recirculating fluid from the fluid dynamic bearing via the passage to the inlet reservoir* of claim 1.¹ Applicant has shown in the record that Moritan, which the Office believes cures the deficiency of Tanaka, in fact does not use the term "capillary seal" in its disclosure. Whether or not Moritan teaches a capillary seal within the broadest reasonable meaning of that term is a disputed issue.

Notwithstanding that dispute, the Office reads Moritan's groove 23b on the *channel* feature of the rejected claims, pointing to Moritan's disclosed purpose for the groove 23b as being "for the desired purpose of permitting smooth assembly of the motor."² Particularly, Moritan discloses that its liquid bearing fluid is necessarily displaced from the sleeve 21 as the result of inserting the shaft 12 into the sleeve 21 in a close mating relationship. The groove 23b, which is in fluid communication with the sleeve 21, directs the displaced liquid

¹ Office Action pg. 4.

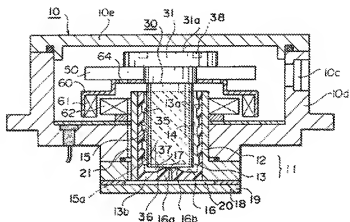
² Office Action pg. 5.

bearing fluid to a reservoir in the space 21a where it can return to the space between the inserted shaft 12 and the sleeve 21.



The Office's stated rationale for combining Moritan and Tanaka is that Moritan's groove 23b (purported *channel*) would allegedly be advantageous in Tanaka for the same reason; "for the desired purpose of permitting smooth assembly of the motor." However, Applicant has shown that the skilled artisan recognizes that the Office's suggested modification of Tanaka to add Moritan's groove 23b for that purpose would be entirely superfluous. That is, the Office's suggestion that there might be some difficulty in assembling Tanaka's shaft into its sleeve needing a solution akin to Moritan's solution is a mischaracterization of what Tanaka actually discloses. Particularly, the skilled artisan recognizes that during such an insertion the gas bearing fluid in Tanaka's sleeve, unlike the liquid bearing fluid in Moritan's sleeve 21 absent its groove 23b, is freely displaceable through the aperture 17 into the space 20 and, in turn, through the groove 21 where it is ultimately exhausted into the enclosure.³

³ Applicant's Response of 7/27/2010 pg. 8.



Contrary to the Office’s mischaracterization of what Tanaka actually discloses, it would in fact not be advantageous to add Moritan’s groove 23b to Tanaka for the alleged purpose of permitting smooth assembly of the motor. Tanaka’s aperture 17, space 20, and groove 21 are already readily configured for the purpose for which the Office believes it would be advantageous to add Moritan’s groove 23b. The fact that the Office’s stated rationale for the suggested combination relies on what the skilled artisan knows to be a mischaracterization of what Tanaka actually discloses belies the existence of any *prima facie* case of obviousness, leaving an unresolved factual issue that must be addressed before it can be said that this case is in condition for appeal.

2. The Office’s rationale for the suggested combination to add a capillary seal to Tanaka is based on a mischaracterization of what the cited references actually disclose, leaving another unresolved factual issue that must be addressed before this case is in condition for appeal.

The Office admits that Tanaka’s gas bearing does not teach or suggest a capillary seal.⁴ The Office’s position is that Moritan’s liquid bearing fluid construction does disclose a capillary seal⁵ although Applicant has pointed out, without rebuttal by the Office, that Moritan never refers to its structure in terms of it including a capillary seal.

Applicant has previously pointed out in the record that the Office’s reliance on replacing Tanaka’s gas bearing seal with a capillary seal is fundamentally erroneous for

⁴ Office Action of 5/27/2010 pg. 4.

⁵ *Id.*

proceeding contrary to accepted wisdom of the skilled artisan who would not agree that a capillary seal, within a reasonable interpretation of that term, is applicable for use in a gas bearing.⁶ In answer to Applicant's stated position the Office most recently points to Ikeo (US 6,722,785) which discloses a fluid dynamic bearing configured to use either a gas or liquid bearing fluid.⁷ However, like Moritan, Ikeo does not use the term "capillary seal" at all and therefore the Office has not answered the substance of Applicant's argument in accordance with MPEP 707.07(f) as to why a skilled artisan would be motivated to construct a gas bearing with a capillary seal.

The rules of the PTO require that application claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.⁸ Thus, during examination claims are given their broadest reasonable interpretation consistent with the specification.⁹ The broadest reasonable interpretation is the meaning that the skilled artisan would give to the claim term in view of the associated usage provided in the specification.¹⁰ A construction that is inconsistent with the written description would not be arrived at by the skilled artisan, and is therefore not a reasonable interpretation.¹¹

Here, Applicant has shown, without rebuttal by the Office, that the common meaning of "capillary seal" to the skilled artisan is consistent with the explicit meaning given by the usage of the term in the specification, that it is a seal structure that purposefully ejects gas from the bearing fluid in the bearing:

As persons skilled in the art will understand, the orientation of the flow of bearing fluid through circulation passage 292 beneficially purges trapped air from the fluid dynamic bearing 230 during operation...As the bearing fluid reaches the top of the wall 264 and spill over into the reservoir 277 of capillary seal 278, the trapped air bubbles out of the bearing fluid into the surrounding environment.¹²

⁶ Applicant's Response of 3/1/2010 pg. 8.

⁷ Advisory Action.

⁸ *Phillips v. AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005)(en Banc), quoting 37 C.F.R. § 1.75(d)(1).

⁹ *Phillips, supra*; MPEP 2111

¹⁰ *In re American Academy of Science Technical Center*, 70 USPQ2d 1827 (Fed. Cir. 2004); *In re Cortright*, 49 USPQ2d 1463, 1468 (Fed. Cir. 1999); *In re Morris*, 44 USPQ2d 1023 (Fed. Cir. 1997)

¹¹ *Phillips, supra*; *In re Morris, supra*; *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

¹² Para. [0037] of the published application (emphasis added).

The skilled artisan recognizes that the Office's suggestion to modify Tanaka's seal structure to eject gas from the bearing fluid is in fact a suggestion to proceed against the accepted wisdom of the skilled artisan because Tanaka's bearing fluid itself is a gas. The Office has failed to substantiate an answer to Applicant's argument that the skilled artisan would not include a capillary seal in a gas bearing construction, which belies any existence of a *prima facie* case of obviousness and leaves another unresolved factual issue that must be addressed before it can be said that this case is in condition for appeal.

Conclusion

For these reasons, Applicant respectfully requests that the Panel withdraw the final rejection for further prosecution on the merits so that these unresolved factual issues can be addressed.

Respectfully submitted,

By: /Mitchell K. McCarthy/
Mitchell K. McCarthy, Registration No. 38,794
McCarthy Law Group
512 Northwest 12th Street
Oklahoma City, Oklahoma 73103
1.877.654.6652 or 405.639.3082
www.mccarthyiplaw.com